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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,105	09/18/2003	Edward L. Gibbs		7136

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EXAMINER

KERNS, KEVIN P

ART UNIT PAPER NUMBER

1725

DATE MAILED: 04/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/666,105	<b>Applicant(s)</b> GIBBS, EDWARD L.	
	<b>Examiner</b> Kevin P. Kerns	<b>Art Unit</b> 1725	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 January 2006 and 27 February 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 15-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 September 2003 and 03 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/26/05, 1/3/06</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The five information disclosure statements filed 9/14/05, 10/3/05, 12/28/05, 1/25/06, and 3/27/06 fail to comply with 37 CFR 1.97(c) because they lack fees set forth in 37 CFR 1.17(p). The 5 IDS's have been placed in the application file, but the information referred to therein has not been considered.

### ***Inventorship***

2. The request to correct the inventorship in this nonprovisional application under 37 CFR 1.48(c) requesting addition of an inventor(s) is deficient because: the Request to Correct Inventorship document received by the USPTO on January 5, 2004 has an incorrect serial no. 10/661,105, rather than the correct 10/666,105, on the Request to Correct Inventorship sheet, all three sheets that were each signed by the three inventors, and the Declaration and Power of Attorney sheet. Correction is required.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 15-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Senn (US 4,174,475) in view of Ahn (US 5,403,985).

Senn discloses a welding structure for spot welding steel mesh (flat panel framework having opposed first and second sides, with each side having plural conductive surfaces, to be horizontally positioned at a first welding position), in which the apparatus comprises a plurality of welding stations (multiple welding guns 120 with electrodes 124 each having a planar contact surface for simultaneous welding) arranged in first and second rows and having a plurality of adjacent lower electrodes 132 each having a planar contact surface, such that the combination of electrodes (124,132) are "capable of" and "adapted to" welding a plurality of surfaces, including curvilinear and planar surfaces; and an advancing means in the form of a roller conveyor 168 that is capable of transporting the flat panel framework horizontally to a second welding position (abstract; column 1, lines 7-16 and 34-63; column 2, line 17 through column 5, line 51; and Figures 1-3).

With regard to the dimensions and spacings of the electrodes with in comparison to the dimensions/spacings of the portions of workpieces to be welded (claims 22-25 and 31-33), one of ordinary skill in the art would have recognized that the welding current supplied by the welding apparatus would necessarily have to be adequate to perform optimum welding, as lack of welding current (which depends in part to the dimensions and spacings of the welding electrodes) would not obtain a high strength weld, and too much current would deform the workpiece(s). As a result, it would have

been obvious to one of ordinary skill in the welding art to provide welding electrodes of adequate dimensions and spacings, in order to obtain plural high-quality welds.

With regard to the claim limitations that relate to details of the article (including substructures of the flat panel framework) that is placed on the welding apparatus (claims 19-21, 26, and 28-30), a recitation of the intended use of the claimed invention (apparatus) must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Regarding the specific details of the flat panel framework (article), these limitations are directed to a manner of operating the welding apparatus. The examiner notes that neither the manner of operating a disclosed device nor material/article worked upon further limit an apparatus claim. Said limitations do not differentiate apparatus claims from the prior art. See MPEP 2114 and 2115. Further, the examiner notes that intended use limitations, such as "for welding a panel" do not have patentable weight in an apparatus claim. See *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969) that states "Expressions relating the apparatus to contents thereof and to an intended operation are of no significance in determining patentability of the apparatus claim." Also see *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) that states "While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function". See MPEP 2114.

Senn does not specifically disclose that adjacent first and second electrodes (within the plural welding stations) each have opposed polarities.

However, Ahn discloses a machine for manufacturing construction panels (flat panel framework having opposed first and second sides to be horizontally positioned at a first welding position), in which the machine comprises a plurality of welding stations (multiple spot welding machines 40,42 for simultaneous welding) arranged in first and second rows and having a plurality of adjacent electrodes (200,202) of opposed polarities (positive and negative – see Figure 10) that are closely spaced; and a carriage and carriage driving means 44,46 (conveyor) that is capable of transporting the flat panel framework horizontally to a second welding position, such that the (closely spaced) adjacent electrodes of opposed polarities are advantageous for obtaining three-dimensional construction panels that are assembled and spot welded simultaneously to provide multiple spot welds, thus reducing production time (abstract; column 1, lines 6-17; column 3, lines 10-26; column 4, lines 34-68; column 5, lines 1-11; column 6, lines 14-35; column 7, lines 10-68; column 8, lines 1-32; and Figures 2 and 10).

It would have been obvious to modify the welding structure for spot welding steel mesh, as disclosed by Senn, by using the adjacent electrodes of opposed polarities to weld construction panels, as taught by Ahn, in order to obtain three-dimensional construction panels that are assembled and spot welded simultaneously to provide multiple spot welds, thus reducing production time (Ahn; abstract; column 1, lines 6-17; column 3, lines 10-26; column 7, lines 10-68; and column 8, lines 1-32).

***Response to Arguments***

5. The examiner acknowledges the applicant's amendments and corrected drawing sheet received by the USPTO on January 3, 2006 and February 27, 2006. In addition, the information disclosure statements of 12/26/05 and 1/3/06 (the only eIDS's provided with fees) have been considered and initialed, and these eIDS sheets are enclosed with this Office Action. The remaining (5) information disclosure statements (see various dates given in above section 1) have not been considered due to lack of fees (no authorization to remove fees given by applicant -- differing from the two eIDS's that were considered). Also, the inventorship (as noted by the applicant on page 31 of the remarks dated January 3, 2006) misidentifies the serial no. in the applicant's communication of January 5, 2004 (see above section 2). The corrected drawing sheet and specification and claim amendments overcome prior objections to the drawings and specification, in addition to prior 35 USC 112, 2<sup>nd</sup> paragraph rejections. Furthermore, the applicant's amendments overcome all prior rejections under 35 USC 102(b). The applicant has added new claims 19-34. Claims 15-34 are currently under consideration in the application.

6. Applicant's arguments with respect to claims 15-18 (now claims 15-34) have been considered but are moot in view of the new ground(s) of rejection.

With regard to the applicant's remarks/arguments on pages 21-26 (addressing the Senn and Ahn references), the applicant is referred to the newly underlined portions of above section 4, which highlights changes to the rejections (as compared to the prior

Office Action), as necessitated by the applicant's amendments to the claims. In addition, the rejections to most of the new claims have been expanded (see the two "With regard to..." paragraphs in above section 4).

### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kevin P. Kerns whose telephone number is (571) 272-1178. The examiner can normally be reached on Monday-Friday from 8:00am-5:00pm.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached on (571) 272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kevin P. Kerns *Kevin Kerns 4/11/06*  
Primary Examiner  
Art Unit 1725

KPK  
kpk  
April 11, 2006